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PATENT
#8/APPAL
BRIEF

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: G.L. Pollon et al. Attorney Docket No. LAMA116222
Application No.: 09/677,495 Group Art Unit: 3711
Filed: October 4, 2000 Examiner: M.S. Graham
Title: APPARATUS FOR SUPPORTING SPORT PRACTICE TARGETS

APPELLANTS' APPEAL BRIEF

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Seattle, Washington

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November 6, 2002

TECHNOLOGY CENTER R3700

**TO THE COMMISSIONER FOR PATENTS:
ATTENTION: BOARD OF PATENT APPEALS AND INTERFERENCES**

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LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

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LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100



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I. INTRODUCTION

This is an appeal to the Board of Patent Appeals and Interferences from the decision of the Primary Examiner dated May 6, 2002, finally rejecting Claims 1-12 in this application which are set forth in the Appendix.

This brief is submitted under 37 C.F.R. § 1.192. The fee for filing this brief in the sum of \$160 under 37 C.F.R. § 1.17(f) is enclosed. The applicants qualify for small entity status.

II. REAL PARTY IN INTEREST

The real party in interest is Retract-A-Sport Inc. by virtue of an assignment of all rights from the inventors to 843001 Alberta Ltd recorded October 4, 2000, at Reel/Frame 011188/0211, and a subsequent change of name from 843001 Alberta Ltd. to Retract-A-Sport Inc. recorded February 27, 2001, at Reel/Frame 011555/0102.

III. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences that will directly affect, be directly affected by, or otherwise have a bearing on the Board's decision in this appeal.

IV. STATUS OF THE CLAIMS

Claims 1-12 are pending in the application and have been finally rejected. It is this final rejection of Claims 1-12 that is being appealed.

V. STATUS OF AMENDMENTS

No amendments to the claims in this application have been filed before or subsequent to the final rejection.

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

VI. SUMMARY OF THE INVENTION

The invention is an apparatus for supporting sport practice targets that can be rapidly positioned on a support structure for use and just as rapidly be taken down. More specifically, the apparatus for supporting sport practice targets includes an elongate container having a sidewall defining an interior cavity with an elongate access opening extending through the sidewall to the interior cavity. A roll of flexible sheet material is disposed within the interior cavity of the container. The sheet material displays one or more graphics depicting sport practice targets. The sheet material has an extended position in which the sheet material extends through the access opening so that the graphics of sport practice targets are visible and a retracted position in which all but a remote peripheral edge of the roll of sheet material is retracted within the container. The sheet of material can be rapidly moved to the extended position for use and just as rapidly be moved to the retracted position for storage.

VII. ISSUES PRESENTED FOR REVIEW

Applicants appeal the final rejection of Claims 1-12. The Examiner rejected Claims 1, 3, 4, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Dubose in view of Lacoste et al. Claim 2 has been finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to Claim 1, and further in view of Galloway et al. Claim 5 has been finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Dubose in view of Thumann. Claim 8 has been finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to Claim 1, and further in view of Lapsker et al. Claims 9-11 have been finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Dubose in view of Thumann and Galloway et al. Claim 12 has been finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to Claim 9, and further in view of Lapsker et al.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

Applicants will focus their argument on independent Claims 1 and 9. The issues are as follows:

1. Whether Claim 1 is patentable under 35 U.S.C. § 103(a) over Dubose in view of Lacoste et al.; and

2. Whether Claim 9 is patentable under 35 U.S.C. § 103(a) over Dubose in view of Thumann and Galloway et al.

VIII. GROUPING OF CLAIMS

For purposes of this appeal, all of the claims can be treated as a single group. As noted above, applicants will focus their present argument on independent Claims 1 and 9. Should the patentability of Claims 1 and 9 be confirmed, the dependent claims are also patentable by virtue of depending from an allowable independent claim.

IX. ARGUMENT

Claim 1 presently stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dubose (U.S. Patent No. 5,876,291) in view of Lacoste et al. (U.S. Patent No. 6,003,583). Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dubose in view of Thumann (U.S. Patent No. 5,505,244) and Galloway et al. (U.S. Patent No. 5,419,549).

Applicants respectfully submit that the Examiner unintentionally used an impermissible hindsight analysis in rejecting the claims, particularly Claims 1 and 9. In the course of prosecution, applicants drew to the Examiner's attention the teachings of Dubose and several other target apparatus that are suspended in front of a garage door. The deficiencies of these references are evident and explained in the background of the invention in the present

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

application. It is only after viewing applicants' invention and recognizing the deficiencies in the Dubose reference that the Examiner turned to retraction mechanisms as disclosed by Lacoste and Thumann to reject the claims. However, the disclosures of Lacoste and Thumann do not cure the deficiencies in the Dubose reference. Moreover, Lacoste and Thumann should not be combined with Dubose as they pertain to entirely different art areas. Though not determinative, this fact is independently acknowledged by the art classification assigned by the U.S. Patent and Trademark Office to these references (Dubose in Class 473 and Lacoste and Thumann in Class 160).

Dubose discloses a golf practice screen that hangs loosely from a structure by flexible cords. A user practices golf by driving golf balls into the practice screen. A principal and featured aspect of Dubose's practice screen is that the screen 16 is provided with "excessive height" so that the lower marginal edge 64 is laid out on the ground forming a curve with the ground. *See* Figure 1. The radius of curvature can be controlled by pulling forward the lower marginal edge 64. The curvature is effective for returning the golf ball to the user. *See* column 3, lines 39-44, and column 7, lines 30-42.

In contrast, neither Lacoste nor Thumann pertain to practice targets for sports. Instead, the disclosures of Lacoste and Thumann are both directed to tightly held retractable screen structures for door openings. Air can pass through the screens while insects are kept out. Thumann discloses a retractable screen for a single door, while Lacoste discloses a retractable screen system for larger doors, the system having two opposing screen assemblies that are securable to each other.

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

It is unreasonable for the Examiner to contend that Thumann and Lacoste are applicable to the present invention simply because they pertain to door opening coverings. On one hand, the present invention is not a door opening covering that seals with the opening to screen out insects. On the other hand, the screen taught by Thumann is not constructed for suspending a target that receives hockey pucks, balls, and the like, that are shot at the screen. The latches holding the screen closed, as disclosed by Thumann, are not designed for such use of the screen and would release when the screen is struck with sufficient force. The screen disclosed by Thumann is meant to form a sealing enclosure with a doorway that readily allows air to pass through, not to provide a medium that stops the forward momentum of hockey pucks or balls. There is absolutely no motivation in the Thumann patent (or anywhere else) to use Thumann's screen for sports practice.

Similarly, the screen system taught by Lacoste is also not intended to provide a target and receive hockey pucks or balls that are shot at the screen. The Lacoste screen system also suffers from an additional deficiency in that should it be used for sports practice (for which use there is absolutely no teaching or suggestion in the Lacoste reference), the vertical supports 38 or locking handles 42 would deflect the hockey pucks or balls off at an angle, resulting in danger to the user or others.

The Examiner contends that the apparatus of the present invention for supporting sport practice targets could be constructed from the screens disclosed by Lacoste or Thumann, needing only a change in the material, addition of a target, and strengthened latches. Applicants note that

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{LLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

in doing so, the Examiner is using an impermissible hindsight analysis to reject the claimed invention. The Examiner's argument inherently first recognizes the new use disclosed by the applicants' invention and then considers what modifications are necessary to the prior art to make the new use workable. Applicants do not claim to have invented screen retraction mechanisms. They do, however, claim to be the first ones to provide a sports practice screen that can be retractably stored in a container, which appears to be borne out by the results of the Examiner's search.

Responding to applicants' arguments, the Examiner states he is not suggesting that the screens of Lacoste or Thumann are designed to stop a ball, as Dubose teaches that feature. The Examiner contends that Lacoste and Thumann have been cited for teaching that "such door opening coverings may be retractably stored in containers for convenience." Applicants strongly disagree in this regard. "Such door opening coverings" in the Examiner's statement refers to sports practice screens designed to receive and absorb the impact of sports projectiles, such as balls and pucks. Lacoste and Thumann teach nothing of "such door opening coverings," nor may "such door opening coverings [that] may be retractably stored in containers" be reasonably inferred from Lacoste and Thumann. As noted above, the screens disclosed by Lacoste and Thumann are intended to form a sealing enclosure with a doorway and readily allow air to pass through. Only with hindsight gained from the present invention does the Examiner combine Lacoste and Thumann with Dubose.

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

For its part, Dubose actually teaches away from the present invention. A principal aspect and featured advantage of the golf practice screen disclosed by Dubose is that it has an extended length sufficient to drape forward on the ground forming a curvature for returning balls to the user. A sports practice screen with a portion lying on the ground does not lend itself to retraction within a container as described and claimed in the present invention. Should one side of the Dubose screen be unhooked from the supporting structure for retraction of the screen, the excess material on the ground would prevent the screen from readily retracting within a container opposite of the unhooked side, as taught by the present invention. The Examiner's contention that the curved ground-contacting portion of Dubose's screen is only "preferable" and "not necessary" is unavailing and without support. Removing the curved material for purposes of retracting the screen is not taught or suggested by Dubose, nor would it have been obvious to remove this feature of Dubose's screen given the state of the art at the time the present invention was made.

When patentability of an invention turns on the question of obviousness, the prior art must include evidence showing a teaching, motivation, or suggestion to select and combine the references to make the present invention. *See, e.g., McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001) ("The central question is whether there is reason to combine [the] references."). As explained by the Federal Circuit:

[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{LLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Moreover, once hindsight analysis is removed, it is readily recognized that one skilled in the art of making sport practice screens, at the time the present invention was made, would not consider eliminating the excess curve-forming material disclosed by Dubose, so that the golf practice screen could be retractably stored. A prior art reference, such as the Dubose patent, must be considered in its entirety, including portions that lead away from the claimed invention. See M.P.E.P. § 2141.02. There is simply no teaching in the Dubose patent that the sports practice screen should be adapted for retraction within an elongate container as claimed in Claims 1 and 9.

An obviousness determination may not draw on hindsight knowledge of the present invention. In other words, the invention must be viewed "not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." *Sensonics Inc. v. Aerosonic Corp.*, 38 U.S.P.Q.2d 1551 (Fed. Cir. 1996). It is simply improper to "[use] that which the inventor taught against its teacher." *In re Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), citing *W.L. Gore v. Garlock Inc.*, 72 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

X. CONCLUSION

Applicants respectfully submit that the Examiner erred in arriving at the conclusion that the sport practice targets claimed in the present application could be constructed from the screens disclosed by Lacoste or Thumann, in combination with Dubose, without any teaching in the art to support that position. It is further respectfully submitted that the Examiner erred in overlooking

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{LLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

teachings in the references which would tend to be contrary to the proposed combination, focusing only upon what modifications are necessary to the prior art to make the new use and new combination workable.

For these reasons, reversal of the claim rejections and allowance of the application is earnestly requested.

Respectfully submitted,

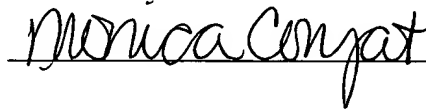
CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Kevan L. Morgan
Registration No. 42,015
Direct Dial No. 206.695.1712

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Date: November 6, 2002



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LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

APPENDIX A - Claims on Appeal

1. An apparatus for supporting sport practice targets, comprising:
an elongate container having a sidewall defining an interior cavity with an elongate access opening extending through the sidewall to the interior cavity;
a roll of flexible sheet material disposed within the interior cavity of the container, the sheet material displaying at least one graphic of a sport practice target, the sheet material having an extended position in which the sheet material extends through the access opening so that the at least one graphic of a sport practice target is visible and a retracted position in which all but a remote peripheral edge of the roll of sheet material is retracted within the container; and
a mounting adapted for mounting the container to a support structure.
2. The apparatus as defined in Claim 1, wherein a sensor is embedded in the sheet material in the vicinity of the at least one graphic of a sport practice target, the sensor being connected to a strike indicator adapted to emit (one of an auditory tone and a visual) signal when the at least one graphic of a sport practice target is struck by a projectile.
3. The apparatus as defined in Claim 1, wherein the sheet material has a background graphic that depicts a sports scene.
4. The apparatus as defined in Claim 3, wherein the sports scene includes advertisements promoting products or services of third parties.
5. The apparatus as defined in Claim 1, wherein the mounting includes a first mounting bracket adapted to secure the container in a vertical orientation to a first vertical support and a second mounting bracket adapted to secure the remote peripheral edge of the roll of sheet material to a second vertical support.

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

6. The apparatus as defined in Claim 1, wherein the first vertical support is a first side of a garage door opening and the second vertical support is a second side of the garage door opening.

7. The apparatus as defined in Claim 1, wherein the sheet material is biased toward the retracted position.

8. The apparatus as defined in Claim 1, wherein the sheet material has a first side with several graphics of sport practice targets for a first sport and a second side with several graphics graphic of sport practice targets for a second sport.

9. An apparatus for supporting sport practice targets, comprising:
an elongate container having a sidewall defining an interior cavity with an elongate access opening extending through the sidewall to the interior cavity;

a roll of flexible sheet material disposed within the interior cavity of the container, the sheet material displaying a graphic of a sports scene with several sport practice targets, the sheet material having an extended position in which the sheet material extends through the access opening so that the graphic of the sports scene with the several sport practice targets are visible and a retracted position in which all but a remote peripheral edge of the roll of sheet material is retracted within the container, the sheet material beings biased toward the retracted position;

sensors embedded in the sheet material in the vicinity of the sport practice targets, the sensors being connected to a strike indicator adapted to emit one of an auditory tone and a visual signal when any one of the sport practice targets is struck by a projectile; and

a mounting adapted for mounting the container to a support structure, the mounting including a first mounting bracket adapted to secure the container in a vertical

orientation to a first vertical support and a second mounting bracket adapted to secure the remote peripheral edge of the roll of sheet material to a second vertical support.

10. The apparatus as defined in Claim 9, wherein the sports scene includes advertisements promoting products or services of third parties.

11. The apparatus as defined in Claim 9, wherein the first vertical support is a first side of a garage door opening and the second vertical support is a second side of the garage door opening.

12. The apparatus as defined in Claim 9, wherein the sheet material has a first side with a graphic depicting a first sport with several sport practice targets appropriate for the first sport and a second side with a graphic depicting a second sport with several sport practice targets appropriate for the second sport.